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10/646,110	08/22/2003	Gerard E. Moy		8430

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Gerard E. Moy
1608 Danube Lane
Plano, TX 75075

EXAMINER

JOHNSON, JERROLD D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/646,110

Applicant(s)

MOY, GERARD E.

Examiner

Jerrold Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention: Figs. 1-8; Figs. 9-13; Figs. 14-19; and Figs. 20-26.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-5, and 10-15 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Gerard Moy on November 17, 2004 a provisional election was made without traverse to prosecute the invention of Figs. 1-8, claims 1-6 and 10-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

Claim 2 and 3 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Even though claim 2 further defines the structure of the clasp, and claim 3 further defines the structure of the "hangers" with the recitation drawn to the "depression", the claims are confusing as "releasable means" as construed under 35 USC 112 6th paragraph and as recited in claim 1 is a narrower limitation than "clasp" as recited in claim 2, and "hanging means" as construed under 35 USC 112 6th paragraph and as recited in claim 1 is a narrower limitation than "hanger" as recited in claim 3. Correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10, 12, 13, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 is confusing. In particular, claim 10 recites in the last two lines of the claim "front back left right sidewall." This recitation is confusing and renders the claim indefinite.

Claims 12 and 13 both use "length" to describe the same dimension. Claim 14 uses the expressions "width" and "depth" in describing these same dimensions.

Correction is required.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3,5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hassel et al. US Patent 5,219,216.

Hassel discloses a hanging file folder storage box system for the storage of a plurality of items in a hanging file system comprising:
a generally rectangular box portion having a bottom panel, front, rear, left, and right sidewalls which are integrally attached to the bottom panel at the bottom edge of said sidewalls, the upper edge of said sidewalls defining an open top, wherein said bottom panel together with said front, rear, left, and right sidewalls define a rectilinear chamber for the storage of items therein; a generally flat lid hingibly attached to one of said sidewalls of said box portion and sized to cover and close said open top of said box portion; releasable means (Fig. 8) for keeping said lid in a closed position adjacent the

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open top of the box portion; at least one fixed partition 29 which is integrally attached to the inner surface of the box portion said fixed partition defining compartments for the storage of items therein; and, two hanging means 18 integrally attached to the outer surface of the left and right sidewalls for supporting said storage box along the bars of said hanging filing system. The hanging means for supporting the storage box comprises hangers which extend from the outer surface of said left and right sidewalls proximate the front edge thereof, the hangers having a depression in their lower edge thereof thereby providing a means to rest stably over the bars of a hanging file system.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hassel. Hassel as described above, discloses the claimed limitations but does not show the storage of items to be stored being selected from the list consisting of staples, tape dispensers, paper clips, pens, pencils, marking pens, labeling mechanisms, note pads,

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souvenirs, jewelry, coins, keys, buttons, sewing needles, sewing thread, nails, drill bits, nuts, and bolts. Hassel is inherently capable of the storage of such items, and to modify the box of Hassel to have specifically accommodated such items would have been obvious at the time of the invention, as it would have increased the functionality of the storage box.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hassel. Hassel, as described above, discloses the claimed limitations. Hassel does not disclose a portion of the outer surface of said front sidewall has labeling means for ease of identification of the contents of the storage box while in operative engagement within a hanging file system. Hassel does, however, disclose in column 4 lines 29 through 38 the use of labels, or "labeling means" as it is claimed, disposed on the underside of the lid.

It would have been obvious to have modified the labeling system of Hassel by the use of labels on the front sidewall as such a change in location would move the label to a location where it would not obstruct the viewing of items through the lid. Additionally, the location of the label is not patentably significant, as the functionality of the label remains constant regardless of where it is placed.

Claims 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hassel et al. in view of Chen US Patent 5,826,719. Hassel, as described above, discloses the claimed limitations. Additionally, Hassel discloses a clasp at the center of the lid as can be seen in Fig. 8, but remains silent as to whether the clasp is hingibly attached to the

lid. The clasp interacts with a hook shown as element 19, but which is not described in the specification.

Chen discloses the common hingibly attached clasp and hook system. It would have been obvious at the time of the invention to have modified the clasp of Hassel with the clasp of Chen, as such clasps are well known to provide a simple secure and durable closure arrangement for storage boxes.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hassel in view of Ong US Patent 5,971,166. Hassel, as described above, discloses the claimed limitations but only discloses two hangers.

Ong does disclose a hanging file folder storage box system, where four hangers are used. It would have been obvious at the time of the invention to have modified the hanging file folder storage box system of Hassel with the use of four hangers as taught by Ong. Such a duplication of known claimed elements is commonly done to multiply the benefits provided by those elements and is known not to be patentably significant. In this case it would be obvious to modify the hanging system of Hassel through the teachings of Ong by replacing the two long hangers of Hassel with four shorter hangers of Ong, as such a change would decrease manufacturing material costs and would result in no loss in the functionality of the system.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hassel in view of Chen, US Patent 5,219,216.

Hassel, as described above, discloses the claimed limitations, and further discloses removable partitions 39 but remains silent as to the exact configuration of these partitions.

Chen in Fig. 5 discloses the well known removable partition configuration of a bottom edge, top edge, and two lateral edges, two members defining a solid cross-section wherein said cross-section thereof is slightly larger than the width of said rectangular portion, said two members are integrally attached to said two lateral edges along their entire extent, said removable partition being slidably received in a plurality of pre-selected opposing pair of slots, said opposing pair of slots having essentially the same shape as said two members and fashioned to be slightly larger in girth. Chen discloses the slots either being disposed within a protrusion in a partition 35 prior to it being fixed within the box, or being formed within the lateral sides of the inner surface of said front back left and right sidewall without a protrusion.

It would have been obvious at the time of the invention to modify the storage box of Hassel with the teachings of Chen, as such a modification would increase the functionality of the storage box so as to accommodate a greater number of types of items. It further would have been obvious to use the protrusions 37 of Chen, as currently are shown on partitions 35, also along the sidewalls. Such a modification would have decreased the materials necessary to construct the sidewalls as compared to the arrangement shown by Chen where the slot is disposed in a thick sidewall.

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassel in view of Pangerc et al., US Patent 6,698,609.

Hassel, as described above, discloses the claimed limitations, but does not disclose fixed partitions extending the full length from the front and rear sidewalls as is claimed in claim 12, or the full length from the left sidewall to right sidewall. Hassel also does not disclose at least one widthwise oriented fixed partition which extends parallel to said front and rear sidewalls within said rectilinear chamber; and, at least one depthwise oriented fixed partition which extends parallel to said the left and right sidewall within said rectilinear chamber, wherein said rectilinear chamber may be divided into a plurality of compartments.

Pangerc further discloses at least one widthwise oriented fixed partition 64 which extends parallel to said front and rear sidewalls within said rectilinear chamber the entire distance from the left and right sidewalls; and, at least one depthwise oriented fixed partition (unnamed partition on which reference number 120 is printed) which extends parallel to said the left and right sidewall within said rectilinear chamber, wherein said rectilinear chamber may be divided into a plurality of compartments. Pangerc also discloses removable partitions 52.

It would have been obvious at the time of the invention to modify the storage box of Hassel with the fixed and removable partition system of Pangerc, as such a use of fixed and removable partitions would enhance the functionality of the storage box of Hassel allowing it to accommodate a greater number and type of items.

With respect to claim 12, it also would have been obvious at the time of the invention to modify the storage box of Hassel with the teachings of Pangerc in such a way as to orient the fixed partitions in either the orientation shown currently by Pangerc, or to have

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rotated the fixed partitions 90 degrees where they would extend between the front and the rear sidewalls. Such a modification would be obvious to one of ordinary skill in the art as it may be necessary to maximize the utility of the box. Additionally, the exact orientation of the fixed partitions is not patentably significant.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jdj



Mickey Yu
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Group 3700

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